

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Childress et al.	§	Group Art Unit: 2444
	§	
Serial No. 10/753,817	§	Examiner: Anwari, Maceeh
	§	
Filed: January 8, 2004	§	Confirmation No.: 6768
	§	
For: Method and Apparatus for	§	Attorney Docket No.: AUS920030939US1
Supporting Transactions	§	

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PATENT TRADEMARK OFFICE
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REPLY BRIEF (37 C.F.R. 41.41)

This Reply Brief is submitted in response to the Examiner's Answer mailed on July 29, 2009.

No fees are believed to be required to file a Reply Brief. If any fees are required, I authorize the Commissioner to charge these fees which may be required to IBM Corporation Deposit Account No. 09-0447.

RESPONSE TO EXAMINER'S ANSWER

This Reply Brief addresses the Examiner's Section (10) Response to Arguments on pages 7-10 of the Examiner's Answer dated 7/29/2009.

1) Per MPEP 2173.05(e), the failure to provide explicit antecedent basis for terms does not always render a claim indefinite. If the scope of a claim would be reasonably ascertainable by those skilled in the art, then the claim is not indefinite. *Energizer Holdings Inc. v. Int'l Trade Comm'n*, 435 F.3d 1366, 77 USPQ2d 1625 (Fed. Cir. 2006) (holding that "anode gel" provided by implication the antecedent basis for "zinc anode"); *Ex parte Porter*, 25 USPQ2d 1144, 1145 (Bd. Pat. App. & Inter. 1992) ("**controlled stream of fluid**" provided reasonable antecedent basis for "**the controlled fluid**").

In the instant case, Claim 22 recites "a plurality of server data processing systems" and "the plurality of servers". Because there are no other "servers" recited in this claim, the claim scope is reasonably ascertainable by those skilled in the art because the "plurality of servers" is a mere short-hand notation for "plurality of server data processing systems" since "server data processing systems" are also commonly referred to as "servers" to those of ordinary skill in the art. Again, there is no other use of "servers" in this claim so this short-hand notation *does not create any ambiguity*, just like "controlled stream of fluid" and "the controlled fluid" created no ambiguity with similar short-hand notation usage that was allowed by the courts after judicial review.

2) Claim 18 is directed to a tangible embodiment – and not a mere form of energy – since such claim recites a computer readable medium encoded with a computer program product that is operable in a data processing system for monitoring transactions for a set of known nodes in a network data processing system, per Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility.¹

¹ http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/guidelines101_20051026.pdf

3) Appellants arguments/comments are not directed to any ‘motivation’ to combine the references, but instead are directed to a failure of the Examiner to establish prima facie obviousness. Absent such prima facie obviousness establishment, the burden of proof has not yet shifted to Appellants to rebut prima facie obviousness with arguments such as a lack of ‘motivation’ to combine the references.²

The combined teachings of the cited references do not provide any *synergistic interplay* between steps of ‘analyzing’ and ‘initiating’, as is provided by the claimed feature of “*in response to the analyzing the identified transactions, selectively initiating a load balancing process for at least one of the nodes in the set of known nodes to mitigate transaction overload at the at least one of the nodes*”.

4) None of the cited references teach or suggest *receiving cache data from a router*, where the received cache data *includes an identification of a set of known nodes sending data packets for transactions*. The Examiner’s comments regarding data *within a router* (“all routers have stored within them routing tables”) are thus off-topic.

5) The Examiner’s interpretation of “at least one node in the set of known nodes” as merely being “one that is identifiable/reachable by the other network components” fails to take into account the fact that per Claim 1 the claimed ‘set of known nodes’ are specially identified nodes in that they (1) are identified by *an identification including in the received cache data*, and (2) are identified as being *nodes sending data packets* for transactions onto the network data processing system. These nodes are thus very different from ‘identifiable/reachable’ nodes, as per the Examiner’s interpretation.

² In rejecting claims under 35 U.S.C. Section 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). Only if that burden is met, does the burden of coming forward with evidence or argument shift to the applicant. *Id.* All words in a claim must be considered in judging the patentability of that claim against the prior art.” MPEP 2143.03; *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). If the examiner fails to establish a prima facie case, the rejection is improper and will be overturned. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In the absence of a proper *prima facie* case of obviousness, an applicant who complies with the other statutory requirements is entitled to a patent. *See In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

6) Per Claim 2, Appellants previously pointed out that the Examiner had failed to establish prima facie obviousness by failing to address the ‘address resolution protocol cache’ aspect of Claim 2, where the cache data that is received is received from such ARP cache. In an apparent acknowledgement of such prima facie obviousness deficiency, the Examiner now newly asserts in essence that this feature is inherent (“ARP would have to be utilized within the routers” – emphasis added). However, this assertion of use *internal to* a router does not establish prima facie obviousness with respect to *receiving data from* an ARP cache, as per Claim 2 in combination with Claim 1.

7) In response to pointing out that the filing date of Ogielski does not predate the filing date of the present Application, the Examiner now changes position and states “There are various sections of Ogielski that read on the limitation of claim 7”. This is an explicit admission by the Examiner that they failed to establish prima facie obviousness in the final rejection of such claim, and therefore this claim has been erroneously rejected due to such prima facie obviousness deficiency admission. **In rejecting claims** under 35 U.S.C. Section 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). **Only if that burden is met**, does the burden of coming forward with evidence or argument shift to the applicant. *Id.* **If the examiner fails to establish a prima facie case, the rejection is improper and will be overturned.** *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In the absence of a proper *prima facie* case of obviousness, an applicant who complies with the other statutory requirements is entitled to a patent. *See In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). As can be seen, this prima facie obviousness must be established *when actually rejecting the claims*, and not in an Examiner’s Answer – if for no other reason than to afford Appellants an ability to respond in a meaningful way during prosecution via Attorney argument and/or claim amendment. The Examiner’s attempt at ‘shifting gears’ at the 11th hour is a fundamental violation of fairness and due process by denying Appellants’ ability to meaningfully respond to the burden of proof shifting that only occurs *after* prima facie obviousness has been properly established by the Examiner.

8) The cited passage at Ogielski paragraph 0014 does not teach “wherein the cache data is received through an agent located on the router”. Instead, it describes a computer readable medium ‘having instructions’ to collect ‘message routing data’. Therefore, a proper showing of prima facie obviousness has not been established by the Examiner, and accordingly the burden of proof has not shifted to Appellants to rebut the incomplete obviousness assertion. In addition, due to the failure to properly establish prima facie obviousness during the actual final claim rejection, such final rejection is erroneous, and should be overturned.³

9) The Examiner’s reliance on *today’s* state of the art (“Routers have daemons”) fails to address what would have been obvious to those of ordinary skill in the art *at the time of the invention*.

10) The Examiner continues to fail to address the (missing) network dispatcher aspect of Claim 22, even when given the opportunity in their Response to Arguments section in the Examiner’s Answer – and thus the Examiner is implicitly admitting that prima facie obviousness has not been properly established with respect to such claim due to such omission. Accordingly, the burden of proof has not shifted to Appellants, and in addition such claim has been erroneously rejected due to such prima facie obviousness deficiency, as previously substantiated with case law.

11 & 12) The Examiner appears to now attempt to add new reasons for rejecting Claims 23 and 24 (previously, none were given at all). Appellants urge error in such 11th hour sifting-gears approach, for similar reasons to those given above in Rebuttal Response 7) hereinabove.

The Examiner has also failed to establish prima facie obviousness with respect to the claimed network dispatcher that is expressly recited in Claims 23 and 24. Accordingly, the burden of proof has not shifted to Applicants, and in addition such claim has been erroneously rejected due to such prima facie obviousness deficiency, as previously substantiated with case law.

³ If the examiner fails to establish a prima facie case, the rejection is improper and will be overturned. *In re Fine*, supra.

CONCLUSION

The Examiner has failed to properly establish prima facie obviousness with respect to all claims, as described hereinabove and in Appellants' Appeal Brief. Thus, the Examiner has failed to state valid rejections against the claims. Therefore, Appellants request that the Board of Patent Appeals and Interferences reverse the rejections. Additionally, Appellants request that the Board direct the Examiner to allow the pending claims.

/Wayne P. Bailey/

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